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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,457	08/08/2001	Nobuya Okayama	500.40470X00	9085

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/923,457	OKAYAMA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jonathan Ouellette	3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 36-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 36-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. Claims 35 has been cancelled, and Claim 38 has been added; therefore, Claims 1-34 and 36-38 are currently pending in application 09/923,457.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claim 34** are rejected under 35 U.S.C. 102(b) as being anticipated by Archibald et al. (US 5,825,883).
4. As per **independent Claim 34**, Archibald discloses a method for calculating a licensing fee of digital contents comprising: counting the number of pages displaying digital contents (functionally, resource, number of access or invocations, and amount of database access); calculating a fee in accordance with the number of displayed pages (C8 L38-56, Claims 1-4); calculating a total amount of audio visual times for each of the digital contents (meter module) and calculating a copyright fee in accordance with the calculated total amount of audiovisual times (C3-C4, C8 L38-56, Claims 1-4, fee calculated based on metering results).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
6. **Claims 1-33 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Archibald et al. (US 5,825,883).**
7. As per **independent Claims 1, 36, and 37**, Archibald discloses a method (system, computer readable recording medium storing a program) for calculating a licensing fee of digital contents comprising: a step of distributing digital contents from a center side distribution apparatus to a terminal apparatus (Fig.1, C3-C4); a step of calculating a total amount of audiovisual times for each of the digital contents viewed and listened to at the terminal apparatus, by totaling audiovisual records of digital contents of respective users for a plurality of users and for each of the digital contents (meter module); and a step of calculating a copyright fee in accordance with the calculated total amount of audiovisual times for each of the digital content viewed and listened to (C3-C4, C8 L38-56, Claims 1-4).
8. Although, Archibald does disclose distributing the digital applications through several channels (C4 L35-40) and providing user access to several types of digital content and metering use with several different methods (C3-C4, C8 L38-56); Archibald fails to expressly disclose wherein the digital contents are distributed via a shop side distribution

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apparatus; a step of allowing digital contents capable of being accessed (viewed and listened to) at a limited place to be viewed and listened to during a limited time period, wherein the limited time period includes time elapsed between entering and exiting the limited place; and a step of collecting an audiovisual fee according to the length of said limited time period.

9. Baranowski discloses wherein the digital contents are distributed via a shop side distribution apparatus (C2 L35-48, System controller to Transceiver base to Portable device); distributing digital contents limited place to be viewed and listened to during a limited time period, wherein the limited time period includes time elapsed between entering and exiting the limited place (C13, limited place is equivalent to wide-area facility, and limited time can be equivalent to: rental period, hours of retail operation, or while user is in wide-area facility); and a step of collecting an audiovisual fee (rental fee for equipment) according to the length of said limited time period (common rental fee pricing structure).
10. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included herein the digital contents are distributed via a shop side distribution apparatus; a step of allowing digital contents capable of being accessed (viewed and listened to) at a limited place to be viewed and listened to during a limited time period, wherein the limited time period includes time elapsed between entering and exiting the limited place; and a step of collecting an audiovisual fee according to the length of said limited time period, as disclosed by Baranowski in the system disclosed by Archibald, for the advantage of providing a method of for calculating a licensing fee of

digital contents, with the ability to increase system business effectiveness by providing rental equipment to users for accessing available services (C13 L19-33).

11. As per Claim 2, Archibald and Baranowski disclose making the terminal apparatus recognize the contents of a portable recording medium storing an audiovisual period of viewing and listening digital contents at the terminal apparatus (digital content can be released to users through network or recorded medium).
12. As per Claims 3 and 4, Archibald and Baranowski disclose recording personal operation history information and personal preference information managed in the terminal apparatus in a portable recording medium (Archibald: user ID, user data records).
13. As per Claims 5-8, Archibald and Baranowski disclose allowing a trial read of digital contents at the terminal apparatus capable of viewing and listening to the digital contents (Archibald: Fig.4, C9 L26-34, trial period).
14. As per Claims 9-16, Archibald and Baranowski fail to expressly disclose prolonging an audiovisual time of digital contents if an electronic advertisement is viewed and listening to at the terminal apparatus capable of viewing and listening to the digital contents.
15. However, Archibald does disclose offering discounts and incentives to users (C9 L13-25), and Official Notice is taken that compensating users for viewing advertisements was well known to one of ordinary skill at the time the invention was made, as a form of marketing and user incentive; and it would have been obvious to compensate the user with incentives related to receiving digital content.
16. As per Claims 17-32, Archibald and Baranowski fail to expressly disclose printing a portion or all of digital contents, a step of checking whether the digital contents can be

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printed, a step of calculating a copyright fee of the printed digital contents, and a step of displaying the calculated result on a display.

17. However, Archibald does disclose monitoring user actions with digital contents and calculating a fee based on the use of the digital content (C3-C4), and printing information based on digital content was well known to one of ordinary skill in the art at the time the invention was made.
18. Therefore, it would have been obvious to include a printing step to be monitored by the metering system described by Archibald.
19. As per Claims 17-32, Archibald and Baranowski disclose wherein said total amount of audiovisual times is a number of audiovisual times of identical digital contents.
20. As per **independent Claim 33**, Archibald discloses a method for calculating a licensing fee of digital contents comprising: calculating a total amount of audiovisual times for each of the digital contents viewed and listened to; and calculating a copyright fee in accordance with the calculated total amount of audiovisual times (C3-C4, C8 L38-56, Claims 1-4).
21. Although, Archibald does disclose providing user access to several types of digital content and metering use with several different methods (C3-C4, C8 L38-56), Archibald fails to expressly disclose outputting the digital contents capable of being accessed at a limited place during a limited time period, wherein the limited time period includes time elapsed between entering and exiting the limited place; collecting an audiovisual fee according to the length of said limited time period.

22. Baranowski discloses distributing digital contents limited place to be viewed and listened to during a limited time period, wherein the limited time period includes time elapsed between entering and exiting the limited place (C13, limited place is equivalent to wide-area facility, and limited time can be equivalent to: rental period, hours of retail operation, or while user is in wide-area facility); and a step of collecting an audiovisual fee (rental fee for equipment) according to the length of said limited time period (common rental fee pricing structure).
23. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included outputting the digital contents capable of being accessed at a limited place during a limited time period, wherein the limited time period includes time elapsed between entering and exiting the limited place; collecting an audiovisual fee according to the length of said limited time period, as disclosed by Baranowski in the system disclosed by Archibald, for the advantage of providing a method of for calculating a licensing fee of digital contents, with the ability to increase system business effectiveness by providing rental equipment to users for accessing available services (C13 L19-33).

***Response to Arguments***

24. Applicant's arguments with respect to claims 1-34 and 36-38 have been considered but are not persuasive. The rejection will remain as **FINAL**, based on the cited prior art.
25. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within



TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

26. As per Claim 34, the Applicant has made the argument that the cited prior art fails to teach or suggest counting the number of pages displaying digital contents and calculating a fee based on the number of displayed pages.
27. However, Archibald does disclose monitoring/charging for user consumption, based on several different criterion, such as time, time increments, functionally, resource, *number of access or invocations (equivalent to displayed pages)*, and amount of database access (C8 L38-56).
28. As per Claims 1, 33, 36, and 37, the Applicant has made the argument that the prior art fails to expressly disclose a step of allowing digital contents capable of being accessed (viewed and listened to) at a limited place to be viewed and listened to during a limited time period, wherein the limited time period includes time elapsed between entering and exiting the limited place; and a step of collecting an audiovisual fee according to the length of said limited time period.
29. However, Baranowski discloses distributing digital contents limited place to be viewed and listened to during a limited time period, wherein the limited time period includes time elapsed between entering and exiting the limited place (C13, limited place is

equivalent to wide-area facility, and limited time can be equivalent to: rental period, hours of retail operation, or while user is in wide-area facility); and a step of collecting an audiovisual fee (rental fee for equipment) according to the length of said limited time period (common rental fee pricing structure).

30. Furthermore, the Applicant has made the argument that the prior art fails to teach or disclose a step of calculating a total amount of audiovisual times for each of the digital contents viewed and listened to at the terminal apparatus, by totaling audiovisual records of digital contents of respective users for a plurality of users and for each of the digital contents; and a step of calculating a copyright fee in accordance with the calculated total amount of audiovisual times for each of the digital content viewed and listened to.
31. However, Archibald discloses a step of calculating a total amount of audiovisual times for each of the digital contents viewed and listened to at the terminal apparatus, by totaling audiovisual records of digital contents of respective users for a plurality of users and for each of the digital contents (equivalent to meter module – which monitors/counts amount of digital content used); and a step of calculating a copyright fee in accordance with the calculated total amount of audiovisual times for each of the digital content viewed and listened to (C3-C4, C8 L38-56, Claims 1-4, fee calculated based on metering results).
32. As per Claims 9-16, the Applicant has made the argument that the prior art fails to teach or disclose prolonging an audiovisual time of digital contents if an electronic advertisement is viewed and listening to at the terminal apparatus capable of viewing and listening to the digital contents.

33. However, Archibald does disclose offering discounts and incentives to users (C9 L13-25), and Official Notice was taken that compensating users for viewing advertisements was well known to one of ordinary skill at the time the invention was made, as a form of marketing and user incentive; and it would have been obvious to one of ordinary skill in the art at the time the invention was made, to compensate the user with incentives related to receiving digital content.

### *Conclusion*

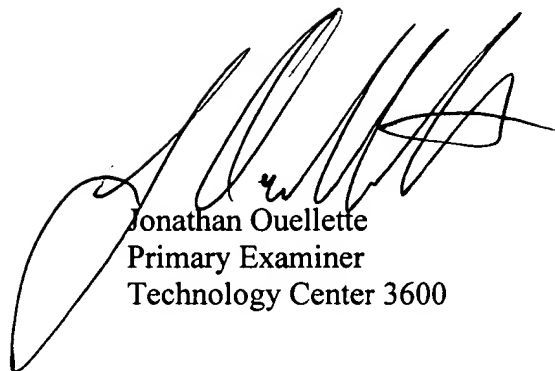
34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
35. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
36. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

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Jonathan Ouellette  
Primary Examiner  
Technology Center 3600